

REMARKS

In the Final Office Action and Advisory Action,¹ the Examiner:

- (1) rejected claims 1, 3, 5, 7-13, 19, 20, 25, 27, 29-31, and 33-37 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,721,906 (*Siefert*) in view of U.S. Patent No. 6,820,082 (*Cook*), U.S. Patent Application Publication No. 2003/0130994 (*Singh*), and U.S. Patent Application Publication No. 2003/0046401 to Abbott (*Abbott*);
- (2) rejected claims 6, 14-16, 18, and 32 under 35 U.S.C. § 103(a) over *Siefert* in view of *Cook*, *Singh*, *Abbott* and U.S. Patent Application Publication No. 2005/0086204 (*Coiera*); and
- (3) rejected claim 17 under 35 U.S.C. § 103(a) over *Siefert* in view of *Cook*, *Singh*, *Coiera*, *Abbott* and U.S. Patent No. 6,636,837 (*Nardozzi*).

By this Amendment, claims 1, 19, 25, 31, and 36 are amended, and claims 39-45 are added. Thus, claims 1, 3, 5-20, 25, 27, 29-37, and 39-45 are pending in this Application.

1. Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of claims 1, 3-20, 25, and 27-38 under 35 U.S.C. § 103(a) over combinations of *Siefert*, *Cook*, *Singh*, *Abbott*, *Coiera*, and *Nardozzi*.

¹ The Final Office Action and Advisory Action contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action or Advisory Action.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit and stated that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. § 2141. In comparing the claim to the prior art, three factual inquiries must be addressed: (1) the scope and content of the prior art must be ascertained; (2) the differences between the claimed invention and the prior art must be determined; and (3) the level of ordinary skill in the pertinent art at the time of the invention was made must be evaluated. See *id.*

Independent claim 1 recites, in part, “receiving at least one selected resource type through the refinement user interface; providing a second narrowed hit-list of resources having the selected resource type from the narrowed hit-list; [and] storing the second narrowed hit-list as a second collection of resources which is used for further actions or stored as a persistent collection.” Independent claim 25, although of different scope, recites similar elements.

The Office Action acknowledges that *Siefert* fails to disclose a narrowed hit-list of resources, and alleges that *Singh* remedies this deficiency. See Final Office Action, pg. 8. Assuming, *arguendo*, that the Office Action’s allegation is correct, which Applicant does not concede, *Singh* still fails to teach or suggest the above-referenced elements of claims 1 and 25.

Singh discloses a system in which a search can be narrowed based upon ISN number, search words, publisher, subject, authors, or title. See paragraph [0204]. These disclosures do not teach or suggest “providing a second narrowed hit-list of resources having the selected resource type from the narrowed hit-list” at least because the search cannot be further narrowed based on a selected resource type.

Cook, Abbott, Coiera, and Nardozzi fail to remedy the deficiencies of *Siefert* and *Singh*, as combinations of *Cook, Coiera, and Nardozzi* also fail to teach or suggest at least “receiving at least one selected resource type through the refinement user interface; providing a second narrowed hit-list of resources having the selected resource type; [and] storing the second narrowed hit-list as a second collection of resources which is used for further actions or stored as a persistent collection,” as recited in claim 1, and similar recitations in claim 25.

In view of the above, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Final Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore a *prima facie* case of obviousness has not been established for independent claims 1 and 25. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 1 and 25 under 35 U.S.C. § 103, as well as the rejections of claims 3, 5-20, 27, and 29-37 which depend from one of claims 1 and 25.

2. New Claims

New claims 39-45 are allowable over the applied art at least based on their dependence on allowable claim 1, as well as for the elements they recite.

3. Conclusion

In view of the foregoing, Applicant requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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